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EXAMINER

BAREFORD, KATHERINE A

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 12/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/501,267

Applicant(s)

ARAM, MEHDI

Examiner

Katherine A. Bareford

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 14-18, 20-25 and 29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-13 and 26-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Claims 6 and 19 are canceled

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date <u>attached</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. The Examiner notes that in a phone interview on Nov. 29, 2005 the basis of the restriction was clarified to attorney B. Buffet, Jr. by Examiner Vishal Patel, and Mr. Buffet confirmed the election of method claims 1-5, 7-13 and 26-28 (as present after the preliminary amendment).
2. Applicant's election with traverse of the method claims of Group I in the reply filed on Nov. 16, 2005 is acknowledged. The traversal is on the ground(s) that (1) the International Searching Authority did not give a lack of unity rejection, and thus, applicant submits that the current restriction requirement is improper. (2) Applicant argues that the subject matter of the two groups is closely related, and thus it would not be a serious burden on the Examiner to examine the complete subject matter of the claims together, as a complete search for the subject matter disclosed in all the claims would overlap. This is not found persuasive because (1) while the ISA did not give a lack of unity rejection, it is not improper for a US examiner to give a lack of unity rejection as long as the requirements for lack of unity are shown under the PCT requirements. As a result, no requirements that are different from those already provided for in the PCT Treaty and Regulations are made. (2) While the subject matter of the claims is related, it would be a serious burden on the Examiner to examine both inventions, as each piece of prior art would have to be examined under two different

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standards due to the different scope of the two different inventions as discussed in the restriction requirement.

The requirement is still deemed proper and is therefore made FINAL.

3. Claims 14-18, 20-25 and 29 (the product claims) are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on November 16, 2005.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 4, 5, 7-9 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCormick (US 4024617) in view of Ogden (US 3066042) and Prasse (US 3617349).

McCormick teaches a method of applying a wear resistant coating material to a surface of a piston ring. Column 1, lines 35-45, column 3, lines 35-40 and column 4, lines 5-30. The method includes application of the coating material by a thermal spray

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process, such as plasma spraying or oxy-acetylene flame. Column 4, lines 5-30. The applied coating material is heat treated at an elevated temperature and for a time effective to at least partially diffuse the coating material into the underlying surface by exposing the material to a heating temperature. Column 4, lines 35-60. The temperature range is such that a plasticizing element or constituent of the coating becomes sufficiently plastic to effect diffusion bonding at the interface of the coating and surface. Column 4, lines 55-60.

Claim 4: the heating is provided by induction. Column 4, lines 35-60.

Claim 9: the coating material can be a powder (pulverulent). Column 5, lines 29-35.

Claim 12: the coating material can contain alumina (aluminum oxide). Column 6, lines 60-65.

Claim 13: the coating material can be a cermet. Column 5, lines 29-35.

McCormick teaches all the features of these claims except (1) that multiple layers are put down with a heating diffusion treatment after each layer is applied, (2) the porosity of the resulting piston ring, (3) the even porosity and open pores (claim 5, 7), (4) the layer thickness (claim 8), (5) the heat treatment resulting in necks (claim 11).

However, Ogden teaches applying layers by spraying molten metal and subsequent heat treatment to diffuse the applied coating layer. Column 2, lines 10-60. Multiple thin layers are applied and respective following heat treatments are performed until the desired thickness of the coating is achieved. Column 2, lines 10-60. For

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example, each layer can be 0.003 inches (0.076 mm) thick and the operation repeated four times until a thickness of 0.012 inches results. Column 2, lines 50-60. Ogden teaches that this method gives better results ^{then to} ~~that~~ spray a single thick coating and heat treating, by improving diffusion and providing a stronger mechanical and metallurgical bond. Column 2, lines 40-45.

Prasse teaches coating piston rings with a hard porous metal or alloy. Column 1, lines 45-55. Prasse teaches that the coating can be by thermal spraying, such as plasma spraying. Column 6, lines 10-50. The spray applied coating desirably has an open porosity of 7-20 percent to allow inclusion of an anti-friction agent in the pores. Column 2, lines 55-70.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify McCormick to apply multiple layers of coating with a heating diffusion treatment after each layer is applied as suggested by Ogden with an expectation of desirable diffusion and bonding results, because McCormick teaches applying a coating to a piston ring and performing diffusion heat treatment after coating, and Ogden teaches that when applying a coating and performing diffusion

heat treatment after coating, it is desirable to apply the coating as multiple layers ^{with} ~~and~~

heating diffusion treatment after each layer ~~is~~ applied in order to provide better diffusion and bonding results. As to the temperature used, it would vary based on the coating material used, but McCormick suggests to perform routine experimentation to optimize the temperature by teaching to use a temperature range such that a

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plasticizing element or constituent of the coating becomes sufficiently plastic to effect diffusion bonding at the interface of the coating and surface. It further would have been obvious to one of ordinary skill in the art to modify McCormick in view of Ogden to optimize the porosity based through the diffusion treatment to, for example, an open porosity 7 percent as suggested by Prasse so as to provide a desirable coated piston ring, because McCormick in view of Ogden teach to perform diffusion heat treatment, with Ogden indicating that such treatment reduces porosity, and Prasse teaches that when thermal spray coating a piston ring with a coating, a desirable final porosity is an open porosity seven percent. As to the evenly distributed porosity, this would be an inherent result of applying the thin layers and have the porosity reducing treatment on each layer. As to the layer thickness, Odgen teaches that a desirable individual layer thickness is 0.003 in (0.076 mm). As to the heat treatment resulting in necks, it is the Examiner's position that this would be an inherent result of performing the suggested diffusion heat treatment.

6. Claims 2, 3, 10 and 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCormick in view of Ogden and Prasse as applied to claims 1, 4, 5, 7-9 and 11-13 above, and further in view of Rastegar et al (US 5713129).

McCormick in view of Ogden and Prasse teach all the features of these claims except (1) the relative movement between thermal spray device and heat treatment

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device and the piston ring (claim 2), (2) the rotation about the axis (claim 3, 26), (3) the wire like form of the coating (claim 10).

100 However, Rastegar teaches ~~that~~ applying a thermal spray coating to a piston ring. Column 2, lines 45-55. The method includes rotating a plurality of piston rings about a central axis and spraying a molten material on the outer surface of the piston rings. Figure 1, column 4, lines 5-30 and column 8, lines 25-30. The thermal spray device is thus positioned so that there is relative movement between thermal spray device and the rotating piston rings. Figure 1, column 4, lines 5-30 and column 8, lines 25-30. The thermal spray device can be a high velocity oxy fuel gun (a form of flame spraying). Column 4, lines 5-30. The spray device can be used with either stock (wire) or powder coatings. Column 4, lines 5-30. During the spraying process the spraying apparatus traverses parallel to the longitudinal axis of the rotating piston rings. Column 8, lines 25-30. Multiple passes (that is, layer applications) are used to provide the final thickness of the coating. Column 8, lines 25-30. Rastegar further teaches that a cooling device 18 can be placed facing the piston rings such that cooling air can be applied to the rings after coating. Figure 1, column 4, lines 30-40 and column 8, lines 30-40.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify McCormick in view of Ogden and Prasse to provide the relative movement between the piston ring and thermal spray device/heat treatment device with rotation of the piston ring about its^s axis and the use of powder or wire

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coating material as suggested by Rastegar in order to provide a desirable and efficient application method, because McCormick in view of Ogden and Prasse teach thermal spray application of a coating on piston rings, and Rastegar teaches that a desirable method of thermal spraying piston rings involves using powder or wire coating material fed to a thermal spray device which moves relative to the piston ring while the piston ring is rotated about its axis so that multiple layers of coating material are applied until the final coating thickness is reached. It further would have been obvious to place the heat treatment device relative to the piston rings in a similar fashion to the thermal spray device for immediate treatment as each layer is formed in order to provide for efficient coating, because Rastegar shows that it is known to place another treatment device for post treatment of the coating (in that case, a cooling device to be used after all coating is done) ^{facing the piston rings} and Ogden teaches the desire to heat treat each layer before formation of the next one.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine A. Bareford whose telephone number is (571) 272-1413. The examiner can normally be reached on M-F(6:00-3:30) with the First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on (571) 272-1423. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular communications and for After Final communications.

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Other inquiries can be directed to the Tech Center 1700 telephone number at (571) 272-1700.

Furthermore, information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


KATHERINE BAREFORD
PRIMARY EXAMINER